

## **REMARKS**

This paper is filed in response to the Office Action dated January 15, 2004. As this paper is filed on April 15, 2004, the paper is timely filed.

### **I. Status of Amendments**

Claims 1-42 were pending prior to this amendment. By this amendment, applicant cancels claims 1-42 without prejudice to refile, and adds claims 43-57. Thus, claims 43-57 are now pending.

Because applicant previously paid fees for 3 independent and 42 total claims, no additional fee is required.

### **II. Response to Office Action**

#### **A. General Comments**

Although the application describes various embodiments and makes various statements regarding the “invention,” it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term “invention” may be used to mean various different things.<sup>1</sup> For example, the term “invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term “invention” is defined as follows:

INVENTION – In patent law, the word ‘invention’ has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

“invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The January 15 Office Action**

In the January 15 Office Action, claims 1-5, 8-17, 20-23, 25-29, and 33-40 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Walker et al. (U.S. Patent No. 6,113,495). Further, claims 6, 7, 24, 30-32, and 41 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker et al. in view of Official Notice, and claims 18, 19, and 42 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker et al. in view of Gimmon (U.S. Patent No. 5,096,195). In light of applicants' cancellation of claims 1-42, the rejections are moot. However, applicants have the following comments regarding claims 43-57.

Claim 43 recites a gaming apparatus comprising a value input device, a display element, at least one sound card having at least two audio channels, at least one multi-channel mixer circuit coupled to the at least two audio channels of the at least one sound card, and at least one audio output element coupled to the at least one multi-channel mixer circuit. The gaming apparatus further comprises a central processing unit coupled to the display element, the value input device, the at least one sound card, and the at least one multi-channel mixer circuit. The central processing unit receives a wager via the value input device and causes the display element to display graphics associated with a game. The central processing unit also causes the sound card to provide audio signals associated with the game on at least one of the at least two audio channels, the sound card providing audio signals unassociated with the game on another of the at least two audio channels. Finally, the central processing unit causes the multi-channel mixer circuit to mix the audio signals provided on the at least one of the at least two audio channels and the another of the at least two audio channels.

Applicants submit that independent claim 43 is not anticipated by or unpatentable in view of Walker et al. While Walker et al. discloses "an audio speaker or headset 353" (Col. 7:61 and Figure 3), Walker et al. particularly fails to disclose, teach or suggest at least one sound card having at least two audio channels, and at least one multi-channel mixer circuit coupled to the at least two audio channels of the at least one sound card. In this regard, applicants respectfully disagree with the statement at the top of page 3:

Walker, in col. 5:1-67, col. 7:1-67 and col. 8:1-67, discloses a multi-channel mixer circuit in communication with the audio card, the multi channel mixer circuit facilitates selection of at [least] one audio channel by a user of the game unit.

Applicants reviewed each of the cited columns, but failed to find any evidence of at least one sound card having at least two audio channels, and at least one multi-channel mixer circuit coupled to the at least two audio channels of the at least one sound card. Therefore, claim 43 is not anticipated by or unpatentable in view of Walker et al.

Similarly, while Gimmon discloses that "[t]he audio generator 54 reproduces the sounds stored in storage device 52b of memory 52, which sounds are heard by the player via earphones 28" (Col. 6:9-11 and Figure 4), Gimmon fails to disclose, teach or suggest at least one sound card having at least two audio channels, and at least one multi-channel mixer circuit coupled to the at least two audio channels of the at least one sound card. As was the case with Walker et al., the applicants failed to find any such disclosure, teaching or suggestion in the Gimmon reference for these limitations. Therefore, claim 43 is neither anticipated by nor unpatentable in view of Gimmon.

Independent claim 52 recites receiving a wager, displaying an image associated with a game, providing audio signals associated with the game, and providing audio signals unassociated with the game. Claim 52 further recites mixing at least two audio signals to define a mixed signal with a multi-channel mixer circuit, transmitting the mixed signal to at least one audio output element, and determining a payout associated with an outcome of the game.

Applicants submit that independent claim 52 is not anticipated by or unpatentable in view of Walker et al. or Gimmon, whether taken individually or in combination. Similar to arguments regarding independent claim 43, while Walker et al. discloses "an audio speaker or headset 353" (Col. 7:61 and Figure 3), Walker et al. fails to disclose, teach or suggest particular limitations of claim 52, including mixing at least two audio signals to define a mixed signal with a multi-channel mixer circuit. Additionally, while Gimmon discloses that "[t]he audio generator 54 reproduces the sounds stored in storage device 52b of memory 52, which sounds are heard by the player via earphones 28" (Col. 6:9-11 and Figure 4), Gimmon fails to disclose, teach or suggest mixing at least two audio signals to define a mixed signal with a multi-channel mixer circuit. Therefore, claim 52 is not anticipated by or unpatentable in view of Walker et al. or Gimmon, whether taken individually or in combination.

Finally, because independent claim 43 is allowable, claims 44-51 that depend from claim 43 are allowable. Also, because claim 52 is allowable, claims 53-57 that depend from claim 52 are allowable.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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